REMARKS

In the Office Action mailed July 15, 2003, the Examiner rejected claims 1-3, 6-19 and 22-31, indicated as allowable but objected to claims 20-21 and allowed claims 32-35. Applicants thank the Examiner for the indications of allowable subject matter. Applicants, however, traverse the rejections of claim 1-3, 6-19 and 22-31.

I. Drawings

The Office Action objected to the drawings as being "inconsistent". In particular, the Office Action suggested that Figures 2 and 6, "must have the lower plate as reference item 402 and upper plate as reference item 404." Such change has been made to Figures 2 and 6 and an entire new set of formal drawings is being transmitted herewith.

II. Claim Rejections – 35 USC § 103

The Office Action rejected claims 1-3, 6-19 and 22-31 as being obvious over combinations of the following references: "Handle-O-Meter" to Thwing-Albert Instrument Company (hereinafter referred to as Thwing-Albert); U.S. Patent 3,838,596 to Neuenschwander; U.S. Patent 2,590,839 to Clapham; U.S. Patent 5,790,983 to Rosch et al.; U.S. Patent 3,804,092 to Tunc; U.S. Patent 2,786,352 to Sobota; U.S. Patent 4,103,550 to Alley, Jr. et al.; U.S. Patent 4,567,774 to Manahan et al.; U.S. Patent 3,151,483 to Plummer; and U.S. Patent 4,776,202 to Brar et al. Applicants traverse these rejections on the grounds discussed below.

Traversal of Claim 1 and 6

Applicants traverse the rejection of claim 1 and 6 and each of the claims dependent thereon (i.e., 2-3, 6-19 and 22-31) on the grounds that the motivation for combining references cited by the Office Action is inadequate and/or the Office Action fails to properly assert a prima facie case of obviousness. In particular, the motivation offered by the Office Action to combine Thwing-Albert with Neuenschwander lacks the required level of specificity such that the combination of Thwing-Albert with Neuenschwander is based upon hindsight. Moreover, the

combination of Thwing-Albert with Neuenshwander does not provide the reasonable expectation of success required for a prima facie case of obviousness.

In the case of In re Lee, 61 USPQ2d 1430 (Fed. Cir. 2002), the CAFC wrote, "there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant. Id. at 1433-34 quoting In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). The need for specificity pervades this authority. Id. at 1433-34 See, e.g., In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313,1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 47 USPQ2d (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

The Office Action that issued for the present application, however, does not provide a specific motivation for combining Neuenschwander with Thwing-Albert as required by the above caselaw. Rather, the Office Action for the present application suggests that, "Modifying the method of Thwing-Albert to test a plurality of fabric samples would involve only routine skill in the art since, in the testing community, it is well established and desirable to increase the speed of the testing and/or the number of test performed simultaneously in order to save time and expense." However, the breadth of this motivation forces the Office Action to rely upon hindsight to combine Neuenschwander with Thwing-Albert.

In particular, the Office Action argues that Neuenschwander is capable of, "testing a plurality of samples...in 10 to 15 seconds" and that, "It would have been

obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Thwing-Albert with the teachings of Neuenschwander to obtain a method to test a plurality of fabric samples wherein the throughput rate in not greater than 10 to 15 seconds and the samples are protruded through a slot via a protruding means." However, this argument ignores the apparatus used in Neuenschwander to achieve these testing rates and, in turn, ignores the impossibility or, at the very least, the undesirability of employing such an apparatus for achieving testing rates in the present application.

In particular, Neuenschwander teaches the transfer of samples to, "testing units mounted on a continuously rotating turret assembly; applying a gradually increasing tensile force to each sample until the sample fails; and sensing the amount of tensile force required to fail the sample..." In contrast to this, claim 1 of the present application teaches, "providing an array of at least four fabric samples upon at least one substrate; causing protrusions of each of said fabric samples through openings in said at least one substrate wherein said protrusions are caused by contacting a probe with said fabric samples using an automated system that moves said probe, said fabric samples, or both relative to each other and wherein said protrusions are caused at a throughput rate no greater than about two minutes (20 seconds in claim 6) per sample; and monitoring a response of each of said fabric samples to said protrusions for assisting in measuring relative fabric handle for each of said fabric samples."

It would be unlikely and maybe even impossible to adapt "testing units mounted on a continuously rotating turret assembly" as discussed in Neuenschwander to cause "protrusions" according to claims 1 and 6 of the present application. Moreover, it would likely be impossible to use the teachings of Neuenschwander to accelerate the machine of Thwing-Albert to achieve the type of testing and rate of testing recited in claim 1 of the present application. Thus, there is no specific motivation for combining the testing rates of Neuenshwander with the device of Thwing-Albert and, by doing so, the Office Action attempts to recreate claims 1 and 6 of the present application based upon hindsight.

In addition to lacking the proper motivation to combine Neuenshwander with Thwing-Albert, the combination lacks the requisite "likelihood of success" for making

a proper obviousness rejection. The CAFC wrote in In re Vaeck that, "Where claimed subject matter has been rejected as obvious in view of a combination of prior art references, a proper analysis under § 103 requires, *inter alia,* consideration of two factors: (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process; and (2) whether the prior art would also have revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success. Both the suggestion and the reasonable expectation of success must be founded in the prior art, not in the applicant's disclosure." In re Vaeck 20 USPQ2d 1438, 1442 (Fed. Cir. 1991) citing In re Dow Chemical Co., 837 F.2d 469, 473, 5 USPQ 2d 1529, 1531 (Fed. Cir. 1988).

Thus, for the obviousness rejection of the Office Action to be proper, the skilled artisan would be required to have a reasonable expectation of success that modifying the teachings of Thwing-Albert with the teachings of Neuenschwander would result in the "causing [of] protrusions..." as defined in the present application at the rate recited in claim 1. However, as suggested before, Neuenschwander teaches the transfer of samples to, "testing units mounted on a continuously rotating turret assembly; applying a gradually increasing tensile force to each sample until the sample fails; and sensing the amount of tensile force required to fail the sample..." The skilled artisan would likely find it impossible or at least undesirable to use such a "turret assembly" for achieving "protrusions" according to the present application and there is no indication that the teachings of Neuenschwander would assist in accelerating the testing rate of the device of Thwing-Albert. Thus, there is no indication that the skilled artisan would have any expectation of success in modifying the teachings of Thwing-Albert with the teachings of Neuenschwander for "causing protrusions..." according to the present application at the rate recited in claim 1.

Traversal of Claim 9

Applicants also specifically traverse the rejection of claim 9, which is dependent upon claim 1. In addition to the reasons set forth for traversing claims 1 and 6, Applicants traverse the obviousness rejection of claim 9 on the ground that U.S. Patent 5,790,983 to Rosch is improperly combined with Neuenschwander and

Thwing-Albert to make the rejection. In particular, it is very unlikely that the skilled artisan would be motivated to combine any of the teachings of Rosch with the teachings of Neuenschwander and Thwing-Albert.

Claim 9, like claim 1, is directed to a method of screening fabric handle of an array of fabric samples. In contrast, Rosch is directed toward a garment (i.e., a top for a girl). Rosch is not directed toward the screening or even testing of samples. At best, Rosch teaches the use of materials for its garment wherein the materials have certain properties that are determined by conventional tests. As such, the skilled artisan would be very unlikely to use the teachings of Rosch to develop a methodology for screening multiple samples as in the claims of the present application.

Traversal of Claim 25

Applicants also specifically traverse the rejection of claim 25, which is dependent upon claim 1. In addition to the reasons set forth for traversing claims 1 and 6, Applicants traverse the obviousness rejection of claim 25 on the ground that the Office Action ignores the language of claim 25 and, thus, fails to assert a prima facie case of obviousness for claim 25.

MPEP 2143.03 states that, "To establish prima facie obviousness...all the claim limitations must be taught or suggested by the prior art." In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, the MPEP states that, "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). As such, the rejections posited by the Office Action fail to assert a prima facie case of obviousness under 35 U.S.C. § 103.

Claim 25 reads, "The method of Claim 1, further comprised of conducting an analysis selected from the group consisting of relative comparison of the fabric handle of said fabric samples, quantitative measurement of the fabric handle of said fabric samples, and comparison of the fabric handle of said fabric samples with the fabric handle of fabric materials not included in said array." In Paragraph 4 of Page 2 of the Office Action, claim 25 has been rejected, but the Office Action does not mention the language of claim 25 or suggest that either Neuenschwander or Thwing-

Albert include the subject matter of claim 25. As such, Applicants contend that the Office Action does not present a prima facie case of obviousness for claim 25 and the rejection of claim 25 should be withdrawn.

Traversal of Claim 29 and 30

Applicants also specifically traverse the rejection of claims 29 and 30, which are dependent upon claim 1. In addition to the reasons set forth for traversing claims 1 and 6, Applicants traverse the obviousness rejection of claims 29 and 30 on the ground that the combination of Neuenschwander, Thwing-Albert and U.S. Patent 3,151,483 to Plummer as asserted by the Office Action does not teach or suggest the subject matter of claim 29 or 30 as required of an obvious rejection.

In particular claim 29 suggests that, "said protrusions are caused by having said array placed in a movable sample holder translating in a direction normal to blunt end of said at least one probe." Moreover claim 30 suggests that, "said protrusions are caused by having blunt end of said at least one probe translating in a direction normal to said array." The Office Action does not even suggest that any of the references teach the movement of an array relative to a probe nor does the Office Action suggest that any of the references teach the movement of a probe relative to an array." The Office Action merely suggests that Plummer shows the movement of a probe relative to one sample. As such, the Office Action has not asserted a prima facie case of obviousness against claims 29 and 30. Therefore, Applicants request that the rejection of claims 29 and 30 be withdrawn.

CONCLUSIONS

In view of Applicants' remarks, the Examiner's rejections are believed to be rendered moot. Accordingly, Applicants submit that the present application is in condition for allowance and requests that the Examiner pass the case to issue at the earliest convenience. Should the Examiner have any question or wish to further discuss this application, Applicant requests that the Examiner contact the undersigned at (248) 593-9900.

If for some reason Applicant has not requested a sufficient extension and/or have not paid a sufficient fee for this response and/or for the extension necessary to

prevent the abandonment of this application, please consider this as a request for an extension for the required time period and/or authorization to charge our Deposit Account No. 50-0496 for any fee which may be due.

Respectfully submitted,

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